

REMARKS

Claims 25-30 are pending in the application.

Claims 25-30 stand rejected.

Claims 25-30 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner is asserting that the claims cover a computer program per se.

Applicants respectfully traverse these rejections. First of all, claims 25-30 do not necessarily claim a computer program. Instead, these claims are also covering a process or method for performing those steps, wherein the output result is a list of design objects and relationships between the design objects that would deliver the Systems Management services in accordance with the Systems Management solution scope. It is not necessary that a computer be employed in whole or in part to perform the processes recited in these claims. Nevertheless, claims 25-30 do recite statutory subject matter, since they do not merely recite an abstract idea or mathematical algorithm without the output of any useful result.

Moreover, the Congressional intent<sup>6</sup> is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. M.P.E.P. §2106. The subject matter courts have found to be outside the four statutory categories is limited to subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon. *See, e.g., Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874); M.P.E.P. §2106. Claims 25-30 are directed to a method that is not outside the four statutory categories.

Applicants respectfully contend that the inventions in claims 25-30 satisfy the test for statutory subject matter recited in *In re Alappat*, and repeated in *State Street Bank & Trust Co. v. Signature Financial Group*, and *AT&T Corp. v. Excel Communications, Inc.* *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1526, 50 U.S.P.Q.2d

1547 (Fed. Cir. 1999). The claimed inventions produce a useful, concrete and tangible result in, *inter alia*, a list of design objects and relationships between the design objects that would deliver the Systems Management services in accordance with the Systems Management solution scope.

The essential inquiry under *In re Alappat* is to determine whether the claimed subject matter as a whole is directed to a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea" or whether, in contrast, the mathematical concept has been reduced to some practical application rendering it useful. *AT&T Corp.*, 172 F.2d at 1357, 50 U.S.P.Q.2d at 1451 (citing *In re Alappat*, 33 F.3d at 1543, 31 U.S.P.Q.2d at 1556-57). Moreover, in making the determination whether the claimed subject matter as a whole is a disembodied mathematical concept or if the concept has been reduced to some practical application rendering it useful, the claims must be construed in the light of the Specification. *See, AT&T Corp.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451 (stating that more than an abstract idea was claimed in *In re Alappat* because the "claimed invention as whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a *smooth wave form display*") (emphasis supplied). The single claim at issue in *In re Alappat* was directed to a rasterizer and recited elements in means plus function form. *In re Alappat*, 33 F.3d at 1540, 31 U.S.P.Q.2d at 1555. Additionally, none of the limitations recited in the claim at issue expressly claimed a "smooth wave form display". Indeed, the concrete, useful and tangible result relied upon in *In re Alappat*, namely, a smooth uniform display, appears in the background of the invention. *Kuriappan P. Alappat, et al.*, U.S. Patent No. 5,440,676 (col. 1, lines 9-10).

Likewise, in *AT&T Corp.*, the useful, nonabstract result relied upon in holding that the claimed invention was directed to statutory subject matter was that the PIC indicator therein held information about the call recipients PIC, which facilitated differential billing of long-distance calls made by a subscriber. *AT&T Corp.*, 172 F.3d 1358, 50 U.S.P.Q.2d at 1452. However, the claim at issue in *AT&T Corp.* was directed to a method including the steps of generating a message record for an interexchange call,

and including in the message record a PIC indicator having a value which is a function of whether or not the interexchange carrier associated with the terminating subscriber is a predetermined one of the interexchange carriers. *AT&T Corp.*, 172 F.3d at 1354, 50 U.S.P.Q.2d at 1449. Again, there was no express or explicit claim limitation directed to the useful, concrete, and tangible result relied upon in determining that the aforesaid claim was directed to statutory subject matter. *See, Id.* The relied upon PIC indicator that facilitates differential billing of long-distance calls appears, *inter alia*, in the summary of the invention. *Gerard P. Doherty, et al.*, U.S. Patent No. 5,333,184, col. 1, line 66 through col. 2, line 3.

Likewise, in *State Street Bank & Trust v. Signature Financial Group*, a useful and concrete and tangible result not expressed in an explicit limitation in the claim at issue was relied upon in holding that the claim was directed to statutory subject matter. *See, State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601 (holding that the transformation of data by the claimed data processing system produced a useful, concrete and tangible result, namely a final share price momentarily fixed for recording and reporting purposes). The claimed invention recited no limitation directed to either a final share price or means for momentarily fixing the final share price for recording and reporting purposes. *See, State Street Bank*, 149 F.3d at 1371, 47 U.S.P.Q.2d at 1599. Indeed, the relied upon useful, concrete and tangible result in *State Street Bank*, namely a final share price momentarily fixed, is not explicitly recited in the *State Street Bank* patent, but is effectively a distillation of the Summary of the Invention. *See, R. Todd Boes*, U.S. Patent No. 5,193,056, col. 4, lines 36-61. Thus, it is beyond peradventure that when judging the claimed subject matter as a whole to determine patentability under 35 U.S.C. § 101, the claims must be construed in the light of the Specification. In short, the question whether a claim encompasses statutory subject matter focuses on the essential characteristics of the subject matter, in particular its utility. *State Street Bank*, 149 F.3d at 1375, 47 U.S.P.Q.2d at 1602.

The Examiner further asserts that claims 28-30 are a program per se even though they recite a computer program product. Again, Applicants traverse such an assertion for the reasons above. Furthermore, Applicants have amended these claims to ensure that they do not recite a program per se by deleting the term "adaptable."

As a result of the foregoing, Applicants respectfully assert that all of the claims in the Application are in condition for allowance.

Respectfully submitted,

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